

amended.

1. (Amended) A method for advertising over a network and broadcast media combination, comprising the steps of:

receiving at a user's computer at a location on the network an audio signal from a broadcast generated by an advertiser, which audio signal has embedded therein unique coded information;

connecting, without user intervention, the user's computer to an advertiser's location in response to extracting the unique coded information from the audio signal, and the advertiser's location being correlated to the unique coded information;

the step of connecting causing profile information of the user to be sent to the advertiser's location over the network;

receiving the profile at the advertiser's location; and

generating information to forward to the user based upon the user's profile forwarded thereto and forwarding this information to the connected user.

REMARKS

Applicants have carefully reviewed the Office Action dated February 27, 2002. Applicants have amended Claim 1 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

Regarding Claims 1 and 2, provisionally rejected under the judicially created doctrine of double patenting over pending claims of co-pending Application No. 09/625,445, this rejection is overcome by a Terminal Disclaimer in compliance with 37 C.F.R. Sec. 3.73(b) filed herewith.

Regarding Claim 1, rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over U.S. Pat. No. 5,978,773, *Hudetz et al.* in view of U.S. Pat. No. 5,905,521, *Gatto et al.*, this rejection is respectfully

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traversed as follows. It is asserted by the Examiner that “Hudetz teaches the invention substantially as claimed.” In fact, much of claim 1 that is asserted by the Examiner to be taught by the reference is not taught by *Hudetz et al.* This is shown by comparing the steps of claim 1 with the reference.

Hudetz contains no disclosure in the cited passages of “receiving at a user’s computer at a location on the network *an audio signal from a broadcast* generated by an advertiser, which audio signal has embedded therein coded information,” as recited in Claim 1 (as amended to cure an antecedent basis issue).

Hudetz contains no disclosure in the cited passages of “connecting the user’s computer to an advertiser’s location in response to extracting the unique coded information *from the audio signal*, . . .,” as recited in Claim 1.

Hudetz contains no disclosure in the cited passages of “the step of connecting *causing profile information of the user* to be sent to the advertiser’s location over the network,” as recited in Claim 1.

Hudetz contains no disclosure in the cited passages of “generating information to forward to the user *based upon the user’s profile* forwarded thereto . . .,” as recited in Claim 1. Thus, at a minimum, *Hudetz* contains no disclosure of a number of features recited in Claim 1, including an audio signal from a broadcast and profile information of a user. The Examiner is correct that *Hudetz* does not teach that the received signal is a broadcast signal generated by an advertiser. However, a reference cited for teaching or disclosing enumerated steps of a claimed invention must in fact disclose all that it is asserted to disclose, not just selected portions of the steps identified. Here, what is asserted by the Examiner is far less than “substantially as claimed” because at least four of the five steps of claim 1 are not fully disclosed in the reference. Applicants therefor respectfully submit that *Hudetz et al.* fails as a primary reference. Each step asserted to read upon the reference must read upon the reference in its entirety. Accordingly, the combination of *Hudetz et al.* and *Gatto et al.* must fail, because it fails to teach, suggest or otherwise render obvious the combination recited in Claim 1 as amended.

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Further, neither reference teaches extracting the information from the unique coded information *embedded in an audio signal from a broadcast*; and neither reference teaches or discloses the use of *profile information of a user*. Second, also *unlike* the present invention, which responds to the receipt of the audio signal without user intervention, both references require some *action* by the user to establish a connection to an advertiser's location: *Hudetz et al.* requires the user *to enter or scan* a UPC code; *Gatto et al.* requires the user *to give a command* by voice or an ordering device. Given these facts, it cannot be reasonably argued that the Applicants' Claim 1 reads on the combination of or is rendered unpatentable under 35 U.S.C. Sec. 103(a) by, the *Hudetz et al.* and *Gatto et al.* references.

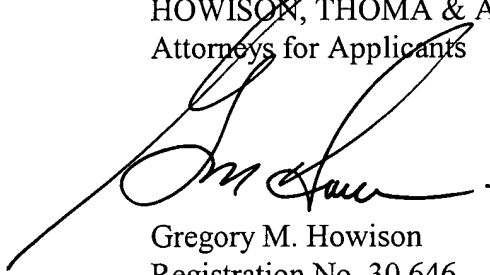
Moreover, even if *Hudetz et al.* disclosed or taught all that is asserted by the Examiner, the *Gatto et al.* reference itself does not supply the missing step identified by the Examiner, namely, from the first step of Claim 1 as amended: "*receiving at a user's computer at a location on the network an audio signal from a broadcast generated by an advertiser, which audio signal has embedded therein coded information.*" The italicized phrases identify portions of the claim which are not taught by *Gatto et al.* It is not enough to suggest a television transmission presenting objects for sale as the stimulus for an action by a viewer without disclosing how such action results. In *Gatto et al.*, the user "receives" information from a broadcast by visually ascertaining sale information displayed on the TV screen about objects for sale. If the user wishes to acquire the object, "the user 17 then operates the ordering means." See *Gatto et al.*, Col. 4, lines 4-10 and Col. 5, lines 53-59. This is distinctly different and teaches away from Applicants' invention in which an audio signal from a broadcast, the audio signal having embedded therein a unique code, is received at the user's computer. In the present invention, the user is not required to perform any action; the computer detects the audio signal, decodes the embedded information, and utilizes it to establish the connection to the advertiser's location, all automatically. Nothing in *Gatto et al.* teaches this automatic process. Thus, there is nothing in this reference that supplies any motivation to combine it with *Hudetz et al.*

For the foregoing reasons Applicants respectfully request the withdrawal of this rejection and the allowance of Claim 1 as amended.

Regarding Claim 2, rejected under the same *Hudetz et al. / Gatto et al.*, combination (though no cite to *Gatto* is given) it is asserted by the Examiner that "Hudetz-Gatto teaches extracting the information from the unique coded information as a unique code" and all of the other steps recited in Claim 2. First, it is noted that Claim 2 is dependent on Claim 1 and contains all of the limitations of Claim 1 as amended, enumerated and discussed hereinabove. Thus Claim 2 must be read as further limiting the method of Claim 1. Thus read, the rejection of Claim 2 fails for the same reasons as does Claim 1. Applicants therefore respectfully request the withdrawal of this rejection and the allowance of Claim 2.

Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-24,738 of HOWISON, THOMA & ARNOTT, L.L.P.

Respectfully submitted,
HOWISON, THOMA & ARNOTT, L.L.P.
Attorneys for Applicants



Gregory M. Howison
Registration No. 30,646

GMH:jk

P.O. Box 741715
Dallas, Texas 75374-1715
Tel: 972-479-0462
Fax: 972-479-0464
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Amended) A method for advertising over a network and broadcast media combination, comprising the steps of:

receiving at a user's computer at a location on the network [a] an audio signal from a broadcast generated by an advertiser, which audio signal has embedded therein unique coded information;

connecting, without user intervention, the user's computer to an advertiser's location in response to extracting the unique coded information from the audio signal, and the advertiser's location being correlated to the unique coded information;

the step of connecting causing profile information of the user to be sent to the advertiser's location over the network;

receiving the profile at the advertiser's location; and

generating information to forward to the user based upon the user's profile forwarded thereto and forwarding this information to the connected user.